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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,346	12/12/2001	Michael D. Hooven	HOOV 115	1028
26568	7590	10/14/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			ROLLINS, ROSILAND STACIE	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/015,346	Applicant(s) HOOVEN, MICHAEL D.	
	Examiner Rosiland S Rollins	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12/4/4/1</u> . | 6) <input checked="" type="checkbox"/> Other: <i>See Continuation Sheet</i> . |

Continuation of Attachment(s) 6). Other: IDS - 5/12;6/7;6/10;6/30;9/29/2004.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-6, 9, 10, 13 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately disclose an embodiment including an electrode of at least one jaw defining an inner lumen and an electrode having a width within the jaw greater than the width of the elongated aperture as recited in claim 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yates et al. (US 5403312). In figure 13, Yates et al. disclose a device for clamping and ablating cardiac tissue comprising; a first handle member; a second handle member; first (332) and second (334) opposed jaw members; a first electrically conductive member (318) carried by the first jaw member; a second electrically conductive member (352) carried by the second jaw member; at least one jaw including a surface for engaging tissue clamped between the jaws, the surface comprising insulative material (355a), an aperture (figure 13) extending through the insulative material and the respective conductive member of such jaw being carried in the jaw and conductive of electrical energy through the aperture to tissue clamped between the jaws.

Claims 1, 14-19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Francischelli (US 6699240). In figures 2a-c, Francischelli discloses a device for clamping and ablating cardiac tissue comprising; a first handle member; a second handle member; first (16) and second (18) opposed jaw members; a first electrically conductive member (100) carried by the first jaw member; a second electrically conductive member (102) carried by the second jaw member; at least one jaw including a surface for engaging tissue clamped between the jaws, the surface comprising insulative material (col. 4 lines 26-29), an aperture (figures 2a-c) extending through the insulative material and the respective conductive member of such jaw being carried in the jaw and conductive of electrical energy through the aperture to tissue clamped

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between the jaws. **Regarding claim 14, 15 and 21** Francischelli illustrates an inner lumen in at least one of the conductive members.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Mulier et al. (US 6096037). Mulier et al. disclose a device for clamping and ablating tissue comprising first and second jaws, each jaw including a tissue engaging surface, an elongated aperture (figures 4 & 5) in the tissue engaging surface and an elongated electrically conductive member (figures 4 & 5) carried by the jaw, which conductive member is generally parallel (as illustrated in the figures) and in proximity to the elongated aperture so as to allow electrical energy to flow through the aperture to tissue engaged between the jaws and the elongated conductive member defining an inner lumen.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. or Francischelli. Yates et al. or Francischelli teach all of the limitations of the claims except the particular dimensions of the conductive member as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a conductive member comprising the dimensions as claimed since, since it

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has been held to be within the general skill of a worker in the art to select the dimensions of a known device on the basis of its suitability for the intended use as a matter of obvious design choice.

Claim 3 and is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates et al. or Francischelli further in view of Imran. Yates et al. or Francischelli teach all of the limitations of the claims except the conductive member comprising gold plated copper. Imran discloses an ablation device and teaches that it is old and well known in the art to use gold plated copper as a conductive material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select gold plated copper as the conductive material for the Yates et al. or Francischelli device, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, particularly in view of the teaching of Imran.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-3, 13-19 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6517536 in view of Yates et al. '312. The claims of the '536 patent teach all of the limitations of the claims of the application except an aperture extending through an insulative material. Mulier et al. disclose a similar device that includes an aperture extending through an insulative material to maintain consistent maximal electrical contact areas. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an aperture extending through an insulative material to maintain a maximal electrical contact area.

Claims 1-3, 13-19 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6517536 in view of Francischelli '240. The claims of the '536 patent teach all of the limitations of the claims of the application except an aperture extending through an insulative material. Mulier et al. disclose a similar device that includes an aperture extending through an insulative material to maintain consistent maximal electrical contact areas. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an aperture extending through an insulative material to maintain a maximal electrical contact area.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

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Regarding the argument that Mulier has neither an elongated aperture nor a conductive member in the relationship as set forth in claim 21, in figures 4 & 5 Mulier illustrates an elongate aperture in which an elongated stainless steel tube is mounted. The stainless steel tube is understood by the Examiner to be an elongated electrically conductive member. The conductive member is generally parallel and in proximity to the elongated aperture as illustrated by figures 4 & 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/3080858.

RKR



**ROSILAND K. ROLLINS
PRIMARY EXAMINER**